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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,321	12/12/2003	George Trevor Dimond	1209.68785	1363

7590 10/31/2005

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EXAMINER
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LONEY, DONALD J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/734,321	<b>Applicant(s)</b> DIMOND ET AL.	
	<b>Examiner</b> Donald Loney	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 33,34,36,37 and 39-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33,34,36,37 and 39-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/23/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 39-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Glatz et al (5904017).

Glatz et al discloses a photo-luminescent material 410 entirely contained within channels in a substrate 401. See figures 3, 4, 7, 9 in Glatz et al which shows photo-luminescent material 312,410,708,902 contained within channels in a substrate. The material is mixed with a plastic material (i.e. carrier/fixer), see column 4, lines 11-40. Glatz discloses the material is heated as it is coextrude and then cures thereafter upon cooling, which fuses the material to the channel (column 8, lines 15-26).

2. Claims 33, 34, 36, 37 and 39-41 are rejected under 35 U.S.C. 102(b) as being anticipated by French (5020256).

French discloses a handrail 1, a recess 3 (i.e. a channel) therein wherein the recess contains a photo-luminescent printed material 4 that extends below the surface of the channel (i.e. recessed). A clear cover material 6 can be placed there over, the cover being disclosed as fusable in order to be fixed into its location Column 2, lines 52-64). The printed matter is disclosed as also being a paint or heat stamped to the

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embodiments of the rail (column 3, lines 41-46 and column 4, lines 13-17). The examiner notes the process limitations in the claims as to the materials being a powder formulation, with carrier, fused to the channel. The examiner deems the final structure of French structurally the same as what would be applicants' final structure since French discloses that their material 4 and carrier 6 are heated as applied to the rail, and would then be fused thereto.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Glatz et al or French in view of the applicants' discussion of the prior art.

The primary references teach the invention substantially as recited except for the additional flow or degassing additives in the luminescent material. French does teach that paint or the like can be used for the luminescent material (column 3, lines 41-46).

On page 8, lines 14-19 the applicant discloses that the luminescent materials are known and would be apparent to the skilled artisan (note spelling).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the primary references to include a flow or degassing agent in the luminescent material, as is known in the art, motivated by the fact that the

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materials are known and French discloses that other forms of materials can be used for the luminescent material.

### ***Response to Arguments***

5. Applicant's arguments filed August 11, 2005 have been fully considered but they are not persuasive. The applicant argues their product is different from Glatz et al due to their process of forming the photo-luminescent using a powder and carrier. However it is the patentability of the product that is in issue not the patentability of the process steps employed to prepare the product. See *In re Fessmann*, 180 USPQ 324 and *In re Brown*, 173 USPQ 685. The examiner deems the prior art product as structurally equivalent to the recited product. The prior art discloses luminescent pigments (i.e. powder) mixed in a polymer that is then extruded into the channel. This would be a fused luminescent material in the channel as recited by the applicant.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

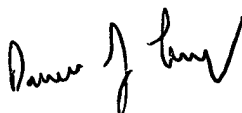
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Donald Loney  
Primary Examiner  
Art Unit 1772

DJL:D.Loney  
10/28/05